

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P. O. Box 7599
Loveland, Colorado 80537-0599

ATTORNEY DOCKET NO. 10030416-1

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FEB 27 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Eric M. Leproust

Serial No.: 10/698,195

Examiner: Katherine D. Salmon

Filing Date: October 30, 2003

Group Art Unit: 1634

Title: METHODS FOR IDENTIFYING SUITABLE NUCLEIC ACID PROBE SEQUENCES FOR USE IN
NUCLEIC ACID ARRAYS

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ☒ Response/Amendment ☐ Petition to extend time to respond
☐ New fee as calculated below ☐ Supplemental Declaration
☒ No additional fee (Address envelope to "Mail Stop Amendments")
☐ Other: (Fee \$ _____)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X 50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X 200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ 360	\$ 0
EXTENSION FEE	1 ST MONTH 120.00 <input type="checkbox"/>	2 ND MONTH 450.00 <input type="checkbox"/>	3 RD MONTH 1020.00 <input type="checkbox"/>	4 TH MONTH 1590.00 <input type="checkbox"/>		\$ 0
					OTHER FEES	\$ 0
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Eric M. Leproust

By

Bret E. Field for Gordon Stewart
Attorney/Agent for Applicant(s)

Reg. No. 37,620

Date: 02-27-2006

Telephone No. (650) 485-2864

I hereby certify that this paper is being facsimile
transmitted to the Patent and Trademark Office on
the date shown below:

571-273-8300

Date of facsimile: 02-27-2006

Typed Name: Donna Macedo

Signature: Donna Macedo

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VIA FACSIMILE 571-273-8300			FEB 27 2006
RESPONSE TO RESTRICTION REQUIREMENT Address to: Commissioner for Patents P.O. Box 1450 Alexandria VA 22313-1450	Attorney Docket Confirmation No.	10030416-1 3542	
	First Named Inventor	Eric M. Leproust	
	Application Number	10/698,195	
	Filing Date	October 30, 2003	
	Group Art Unit	1634	
	Examiner Name	Katherine D. Salmon	
	Title	Methods for Identifying Suitable Nucleic Acid Probe Sequences for Use in Nucleic Acid Arrays	

Dear Sir:

This communication is responsive to the office communication dated February 10, 2006.

In the above referenced office communication, the Examiner imposed a restriction requirement, requiring the election of the claims of either:

Group I, i.e., Claims 1-10, 13-15 and 22;
Group II, i.e., Claims 11-12;
Group III, i.e., Claim 16;
Group IV, i.e., Claims 17-20;
Group V, i.e., Claim 21; or
Group VI, i.e., Claim 23;
for further prosecution in this application.

The Applicants hereby elect Group I with traverse.

The Applicants also respectfully urge the Examiner to rejoin the claims of Groups II-VI with the elected claims of Group I for examination in this application for the following reasons.

The MPEP allows an Examiner to examine otherwise patentably distinct sets of claims if to so would not impose an undue burden on the Examiner. M.P.E.P. § 8.03 states that:

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If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

In the present case, the claims of Groups II-VI are directed to articles for use in performing the methods of Group I, as well as articles and use thereof of the product of the methods of Group I. As such, the search for the claims of Group I will find any relevant prior art relating to the claims of Groups II-VI.

Accordingly, little, if any, additional searching should be required for the claims of Groups II-VI, and therefore the examination of the claims of Groups II-VI together with the claims of elected Group I should impose little, if any, additional burden on the Examiner.

As such, examining the claims of Groups II-VI and the claims of elected Group I together in the present application clearly does not impose an undue or serious burden on the Examiner. In the absence of such an undue or serious burden, the Examiner is clearly instructed by the MPEP to examine the entire application. Therefore, the Examiner is respectfully requested to rejoin the claims of Groups II-VI with the claims of elected Group I and to examine all the claims together in the present application.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

Date: 2-27-06

By: 

Bret E. Field
Registration No. 37,620

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